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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/712,903 | 11/13/2003 | Kazuyuki Ozai | A36085 - 070793.0155 | 9437 |
| 21003 | 7590 | 09/12/2005 | EXAMINER | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | MAYO III, WILLIAM H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2831 | |
| DATE MAILED: 09/12/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,903

Applicant(s)

OZAI ET AL.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawal of Finality

1. Upon further examination, and consideration, the finality of that action mailed on June 30, 2005, is withdrawn to submit a complete and correct rejection as detailed below. The examiner apologizes, in advance, for any inconvenience the withdrawal of finality may cause.

Response to Amendment

2. Based on the withdrawal of the finality of office action mailed on June 30, 2005, the after final amendment submitted on August 25, 2005 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 5-9 and 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the applicant claim language of "a structure for connecting an electrical connector to a coaxial cable" is not

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supported by the specification and therefore doesn't reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (i.e. coaxial cable). This constitutes new matter and the applicant is required to cancel the newly submitted claim language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 5-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (Pat Num 4,923,410) in view of Daane et al (Pat Num 6,580,034, herein referred to as Daane). Suzuki discloses cable-connecting structure (Figs 1-4) for connecting an electrical connector (11) to a cable (9) thereby having controlled

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characteristic impedance, a low level of loss, and a level of crosstalk (Col 1, lines 33-35). Specifically, with respect to claim 2, Suzuki discloses cable connecting structure (Figs 1-4) for connecting an electrical connector (11) to a cable (9) including cable cores (104 & 114) each comprising a core conductor (104) and a core sheath (114) to respective contacts (31) of the electrical connector (11), wherein the cable cores (104 & 114) are capable of peeling a leading end of the cable (Col 3, lines 10-14) to form exposed core conductors (104, Fig 4) of the cable cores (104 & 114) by removing the leading end of the cable (9), wherein a dielectric member (top and bottom 51) having air (at 71) contained therein is arranged to cover at least part of the exposed portions of the cable cores (104) of the cable (9, Col 5, lines 16-18), and wherein the dielectric member (top and bottom 51) comprises a dielectric constant of 1.5-4.5 (i.e. 1-2, Col 5, lines 23-29). With respect to claim 5, Suzuki discloses that dielectric member (top and bottom 51) is arranged to cover at least the core conductors (104) of the exposed portions of the cable cores (104) of the cable (9, Col 5, lines 16-18). With respect to claim 6, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material selected from a group consisting of porous resin materials (i.e. porous resin PTFE, Col 3, lines 55-65). With respect to claim 7, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material selected from a group consisting of porous resin materials (i.e. porous resin PTFE, Col 3, lines 55-65). With respect to claim 9, Suzuki discloses that the dielectric member (top and bottom 51) is provided by embracing at least part of the exposed portions of the cable cores (104) of the cable (9, Fig 4) between two sheets (top and bottom 51) of porous resin material (i.e. porous

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PTFE, Col 5, lines 40-47). With respect to claims 11-12, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material such as porous resin PTFE (Col 3, lines 55-65).

However, Suzuki doesn't necessarily disclose the cable being a coaxial cable comprising a plurality of cable cores (claim 2), nor the dielectric member composed of a sheet of porous resin being winded around the exposed conductor core (claim 8).

Daane teaches a coaxial cable assembly (Figs 1-8) for connection to an electrical connector (22) having a connector housing (24), wherein the coaxial cable assembly (10) has superior flexibility and allows connections to be reliable and efficiently made, compared to prior art cable assemblies (Col 5, lines 4-10). Specifically, with respect to claim 2, Daane discloses a coaxial cable assembly (Fig 7) comprising a plurality of cable cores (32'), wherein each cable core (32') comprises a core wire (54') and a core sheath (44'), for attaching to respective contacts (Fig 1) of the electrical connector (22) by having exposed core conductors (54', Fig 7) of the cable cores (32') by removing the leading end of the cable (Fig 7). With respect to claim 8, Daane discloses that a dielectric member (100) may be wrapped around the exposed conductor cores (32'), wherein the dielectric member (100) made by a porous resin material (i.e. expanded PTFE), for providing the cable assembly (33) with long flex life, while not degrading the flexibility of the cable significantly (Col 5, lines 22-25).

With respect to claim 2, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the structure of Suzuki to comprise the coaxial cable configuration as taught by Daane because Daane teaches

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that such a cable configuration is conventionally utilized in cable connecting structures (Col 1, lines 14-21) and such a configuration has superior flexibility and allows connections to be reliable and efficiently made, compared to prior art cable assemblies (Col 5, lines 4-10).

With respect to claim 8, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the structure of Suzuki to comprise an dielectric member being wrapped around the exposed cable cores as taught by Daane because Daane teaches that such a configuration provides a cable assembly with long flex life, while not degrading the flexibility of the cable significantly (Col 5, lines 22-25).

Response to Arguments

8. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:

- A) Suzuki doesn't disclose a coaxial cable including cable cores.
- B) Suzuki doesn't suggest a method of peeling away a leading end of the coaxial cable because there are no core conductors to be exposed and no leading end to be peeling away.
- C) Suzuki doesn't disclose the dielectric member comprising air.
- D) Kropa doesn't disclose a coaxial cable including cable cores.

- E) Kropa doesn't suggest a method of peeling away a leading end of the coaxial cable because there are no core conductors to be exposed and no leading end to be peeling away.

With respect to argument A, the examiner respectfully traverses. Certainly, as the examiner has readily admitted on the record, Suzuki doesn't disclose the cable assembly being a coaxial cable assembly, however it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to argument B, the examiner respectfully traverses. Clearly, while Suzuki is silent on how the cable ends are exposed, Suzuki teaches the cable ends being exposed (Col 3, lines 10-15, Fig 4). The courts have been consistent that a method of forming a product is not germane to the patentability of the product, unless the method of making produces different structure. Specifically, the method of making the product doesn't add any additional structure because it has been held that the presence of process limitations in product claims, in which the product doesn't otherwise patentably distinguish over the prior art, cannot impart patentability to that product. In this case, clearly the end result, in the claimed invention and the Suzuki reference, is a flat cable comprising exposed conductor ends. Specifically, Suzuki discloses a plurality of exposed cable core conductors (104) being surrounded by a cable core sheath (114), wherein the cable core conductors (104) are exposed on a cable end (Fig 4). The insulation (114) of the Suzuki is clearly capable of being peeled,

as it is made of the same material defined by the applicant. Therefore, with respect to the claim limitation, peeling back a leading end of the cable, it is respectfully submitted that Suzuki clearly meets the structure being claimed.

With respect to argument C, the examiner respectfully traverses. Clearly, Suzuki discloses a dielectric member (top and bottom 51) comprising openings (71) as illustrated in Figs 2 & 3 and described in Column 3, lines 65-68. Clearly, the openings (71) are filled with air. Therefore, it is respectfully submitted that Suzuki clearly teaches the dielectric member (top and bottom 51) comprising air.

With respect to arguments D & E, the examiner respectfully submits that these arguments are moot in view of the newly submitted reference Daane.

Conclusion

9. Applicant's amendment, submitted April 18, 2005, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are Biegon et al (Pat Num 4,767,891), Fritz et al (Pat Num 4,149,026), and Eisenberg et al (Pat Num 5,767,442), all of which disclose cable assemblies.

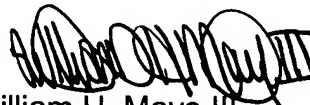
Communication

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Mayo III
Primary Examiner
Art Unit 2831

WHM III
August 31, 2005